

REMARKS

In the Office Action, the Examiner (1) objected to the Abstract; (2) objected to Paragraphs [0002] and [0037] of the Specification; (3) rejected claims 7-22 and 24-29 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,688,397, issued to McClurkin et al. (hereinafter "*McClurkin*"); and (4) rejected claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over *McClurkin* in view of the Applicant's own disclosure. Applicants respectfully request reconsideration in view of the attached amendments and the remarks that follow.

I. Status of the Claims

Claims 1-30 are pending, and stand rejected.

No claims are currently amended.

II. Objection to the Abstract

The Examiner objects to the Abstract because it merely repeats the title. The Abstract is currently amended to conform to the requirements of M.P.E.P. § 608.101(b). Applicants believe the amendments overcome the Examiner's objection to the Abstract.

III. Objection to the Specification

The Examiner objects to Paragraphs [0002] and [0037] of the Specification because these paragraphs contain blanks of missing information. These paragraphs are currently amended to include the previously missing information. Applicants believe the amendments overcome the Examiner's objection to the Specification.

IV. Claims Rejected as Anticipated by *McClurkin*

Claims 7-22 and 24-29 stand rejected as anticipated by *McClurkin*. Claims 7-18 are independent claims, while claims 19-22 and 24-29 depend directly or indirectly from one of claims 1-18.

Apparatus or system claims 7, 10, 13 and 16 each requires a controller programmed to controllably adjust a characteristic of the expansion device as a function of conditions sensed by the sensors and user inputs. Similarly, the remaining independent claims each require controllably

adjusting segments of the expansion device as a function of sensing overlapping ends of tubular members, a threaded connection, a subterranean formation or an operating condition. *McClurkin* does not disclose these limitations.

McClurkin discloses an expansion device 28, such as a mandrel 35, that includes movable portions 34. Movable portions 34 may be moved between a contracted state 38 and an expanded state 40. Also, movable portions 34 may be in the form of fingers 36, all coupled to a compliance mechanism that maintains fingers 36 in the expanded state 40 while allowing individual fingers 36 to contract. The compliance mechanism may be spring-loaded. *McClurkin* further discloses a sensor system 116 including a series of displacement transducers or sensors coupled to segments of expansion device 28, *e.g.*, to fingers 36 of mandrel 35. The sensors “are calibrated to provide diameter measurement that is transmitted back to the surface via a wireline or recorded in one or more memory modules within expansion device 28.” There is no teaching or suggestion by *McClurkin* that any condition sensed by the sensors of sensor system 116 is used to control movement of portions 34 of expansion device 28, *e.g.*, fingers 36 of mandrel 35.

Therefore, *McClurkin* does not anticipate claims 7-18 or their dependent claims 19-22 and 24-29 for at least the same reasons.

V. Claims Rejected as Obvious over *McClurkin* in view of the Applicant’s Disclosure

Claims 1-6 stand rejected as obvious over *McClurkin* in view of the Applicant’s own disclosure. The Examiner relies on the Applicant’s disclosure to teach damping elements, while he relies on *McClurkin* to teach or suggest all of the other limitations of the rejected claims. For reasons presented above, *McClurkin* does not disclose all of the limitations of claims 1-6 unrelated to the damping elements. In particular, *McClurkin* does not teach or suggest a controller programmed to controllably adjust a characteristic of the expansion device as a function of conditions sensed by the sensors and user inputs, or controllably adjusting segments of the expansion device as a function of sensing an operating condition. For these reasons, the combination of *McClurkin* and the Applicant’s own disclosure in regards to damping elements does not render claims 1-6 unpatentable.

CONCLUSION

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. No new matter is introduced by way of amendment. It is believed that each ground of rejection raised in the Office Action dated April 10, 2008 has been fully addressed. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Deposit Account No. 03-2769 (2725-24105) of Conley Rose, P.C., Houston, Texas

Respectfully submitted,



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